

## REMARKS

In the Office Action (“OA”), the Examiner rejected claims 29-30, 33-34, 37-39, 42-43 and 46 under U.S.C. § 103(a) as being unpatentable over O’Donnell, U.S. Patent No. 6,486,875 B1, in view of Silverbrook, U.S. Patent No. 6,238,043. Additionally, the Examiner rejected claim 40 under U.S.C. § 103(a) as being unpatentable over O’Donnell in view of Silverbrook and further in view of Van Ruymbeke, U.S. Patent No. 6,380,930. Further, the Examiner rejected claims 35-36 and 44-45 under U.S.C. § 103(a) as being unpatentable over O’Donnell in view of Silverbrook and further in view of Pertrushin, U.S. Patent No. 6,151,571 A. Still further, the Examiner rejected claims 32 and 41 under U.S.C. § 103(a) as being unpatentable over O’Donnell in view of Silverbrook and further in view of Ebeling, U.S. Patent No. 6,199,292 B1. Additionally, the Examiner rejected claims 19-20, 25-28 and 47 under U.S.C. § 103(a) as being unpatentable over O’Donnell in view of Ebeling, in view of Silverbrook and finally in view of Pertrushin. Finally, the Examiner rejected claim 21 under U.S.C. § 103(a) as being unpatentable over O’Donnell in view of Ebeling, in view of Silverbrook, in view of Pertrushin, and further in view of Van Ruymbeke.

The rejection of claim 31 is listed on the Office Action Summary; however Applicant cannot find an explicit ground for this rejection. Applicant respectfully requests that the Examiner either point to this rejection or clarify it in the next Office Action.

### **I. Response to the Rejection of Claims 29-30, 33-34, 37-39, 42-43 and 46 under 35 U.S.C. § 103(a)**

The Examiner rejected claims 29-30, 33-34, 37-39, 42-43 and 46 under U.S.C. § 103(a) as being unpatentable over O'Donnell, U.S. Patent No. 6,486,875 B1, in view of Silverbrook, U.S. Patent No. 6,238,043. In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Furthermore, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03, ed. 8, rev. 1 (Feb. 2003) (quoting *In re Wilson*, 424 F.2d 1382, 1385 (C.C.P.A. 1970)). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. M.P.E.P. § 2143 at 2100-122 to 127. In this case a *prima facie* of obviousness has not been established because the cited references fail to teach all the claim elements and there would not have been motivation to combine the references.

Claim 29 is directed toward a control device comprising, *inter alia*, "a first structure [and] a second structure including interchangeable function module, wherein said module includes at least one of a laser pointer, a writing implement, or a computer input device." Claims 30-37 depend from claim 29.

Claim 38 is directed toward a control device in the shape of pen comprising, *inter alia*, "[a] top portion of said fuselage including a microphone electrically connected to said electrical components of said fuselage, said microphone enabled to receive audio input from a user to control said electronic devices; and a removable tip adjacent to said bottom portion of said fuselage comprising a function module, wherein said function

module includes at least one of a ink pen module, a lead pencil module, a laser pointer module, or a roller ball mouse module.” Claims 39, 42-43 and 46 depend from claim 38.

O'Donnell teaches a writing instrument consisting of a single structure ending in a ball tip wherein the instrument is intended to capture the distance and direction of the ball tip. This distance and direction data is then recorded within the writing instrument. In the OA, the Examiner admits that O'Donnell does not teach the second structure as claimed and adds Silverbrook to cure this deficiency of O'Donnell. The Examiner would attempt to add the isolated modules (laser pointer and pen module) of Silverbrook to the writing instrument of O'Donnell to construct a device similar to the claimed invention. However, since O'Donnell's writing instrument is a single structure, it would need to be destroyed to add the isolated modules of Silverbrook. Additionally, since one of Silverbrook's modules is a pen module and the tip of O'Donnell's writing instrument is a ball tip used in writing, a person of ordinary skill in the art would not attempt exchange the parts in the manner suggested by the Examiner. The writing instrument is already equipped to be used as a pen. Further, the intention of O'Donnell's invention is to capture the movement of the ball's tip using sensors located near the tip. If one would attempt the add Silverbrook's modules, this intended use would be destroyed.

Therefore, Applicant submits that claims 29-30, 33-34, 37-39, 42-43 and 46 are not obvious in view of the combination of O'Donnell in view of Silverbrook. Specifically, Applicant submits that by combining the teachings of Silverbrook with that of O'Donnell in the manner suggested by the Examiner would render the invention of O'Donnell unsuitable for its intended purpose. According to MPEP 2143.01(V), if proposed modification would render the prior art invention being modified unsatisfactory

for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Therefore, if there is no suggestion or motivation to make the proposed modification as suggested by the Examiner, claims 29-30, 33-34, 37-39, 42-43 and 46 cannot be obvious in view of the combination of O'Donnell in view of Silverbrook.

Additionally, according to MPEP 2143.01 (VI), if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Since the tip of O'Donnell writing instrument require sensors to track the movement of the ball's tip, the replacement of one of Silverbrook's modules would not allow O'Donnell's invention to function as intended. Therefore, claims 29-30, 33-34, 37-39, 42-43 and 46 cannot be obvious in view of the combination of O'Donnell in view of Silverbrook.

Since O'Donnell and Silverbrook do not render claim 29 obvious, this combination of references cannot render dependent claims 30-37 obvious because these dependent claims contain all the limitations of their parent claim. Likewise, since O'Donnell and Silverbrook do not render claim 38 obvious, this combination cannot render dependent claims 39, 42-43 and 46 obvious.

## **II. Response to the Rejection of Claim 40 under 35 U.S.C. § 103(a)**

Claim 40 depends from claim 38 and, thus, incorporates the elements of that claim. As mentioned above, the combination of O'Donnell and Silverbrook as proposed by the Examiner would not render claim 38 unpatentable for two reasons. First, the proposed modification of Silverbrook's modules would render O'Donnell's invention unsatisfactory for its intended purpose. Therefore, there is no suggestion or motivation to make the proposed modification as suggested by the Examiner. Second, the proposed modification of O'Donnell's writing instrument with Silverbrook's modules would change the principle of operation of the prior art invention of O'Donnell. Therefore, the teachings of the references are not sufficient to render the claims *prima facie* obvious.

(*See* current response, remarks, § I.)

Van Ruymbeke, U.S. Patent No. 6,380,930, is directed toward a laptop touchpad with integrated antenna. *See Van Ruymbeke*, Fig. 4. Van Ruymbeke, however, fails to cure the deficiencies of the Examiner's proposed modification. There is nothing in Van Ruymbeke's disclosure that would enable O'Donnell's writing instrument to function as intended by replacing a portion of the instrument with a module of Silverbrook.

Since Van Ruymbeke fails to cure the deficiencies of the combination of O'Donnell and Silverbrook, a *prima facie* case of obviousness has not been established for claim 40. For at least this reason, the rejection of claim 40 under section 103(a) is improper and should be withdrawn.

**III. Response to the Rejection of Claims 35-36 and 44-45 under  
35 U.S.C. § 103(a)**

Claims 35-36 depend from claim 29 and claims 44-45 depend from claim 38 and, thus, incorporates the elements of that claim. As mentioned above, the combination of O'Donnell and Silverbrook as proposed by the Examiner would not render claims 29 and 38 unpatentable for two reasons. First, the proposed modification of Silverbrook's modules would render the O'Donnell's invention unsatisfactory for its intended purpose. Therefore, there is no suggestion or motivation to make the proposed modification as suggested by the Examiner. Second, the proposed modification of O'Donnell's writing instrument with Silverbrook's modules would change the principle of operation of the prior art invention of O'Donnell. Therefore, the teachings of the references are not sufficient to render the claims *prima facie* obvious. (See current response, remarks, § I.)

Pertrushin, U.S. Patent No. 6,151,571 A, is directed toward a method and system for monitoring a conversation between a pair of speakers for detecting an emotion of at least one of the speakers. See *Pertrushin*, Abstract. Pertrushin, however, fails to cure the deficiencies of the Examiner's proposed modification. There is nothing in Pertrushin's disclosure that would enable O'Donnell's writing instrument to function as intended by replacing a portion of the instrument with a module of Silverbrook.

Since Pertrushin fails to cure the deficiencies of the combination of O'Donnell and Silverbrook, a *prima facie* case of obviousness has not been established for claims 35-36 and 44-45. For at least this reason, the rejection of claims 35-36 and 44-45 under section 103(a) is improper and should be withdrawn.

#### **IV. Response to the Rejection of Claims 32 and 41 under 35 U.S.C. § 103(a)**

Claim 32 depends from claim 29 and claim 41 depends from claim 38 and, thus, incorporates the elements of that claim. As mentioned above, the combination of O'Donnell and Silverbrook as proposed by the Examiner would not render claims 29 and 38 unpatentable for two reasons. First, the proposed modification of Silverbrook's modules would render the O'Donnell's invention unsatisfactory for its intended purpose. Therefore, there is no suggestion or motivation to make the proposed modification as suggested by the Examiner. Second, the proposed modification of O'Donnell's writing instrument with Silverbrook's modules would change the principle of operation of the prior art invention of O'Donnell. Therefore, the teachings of the references are not sufficient to render the claims *prima facie* obvious. (See current response, remarks, § I.)

Ebeling, U.S. Patent No. 6,199,292 B1, is directed toward a device that measures dimensional attributes of an object and transmits the dimensional attributes to a remote device. See *Ebeling*, Abstract. Ebeling, however, fails to cure the deficiencies of the Examiner's proposed modification. There is nothing in Ebeling's disclosure that would enable O'Donnell's writing instrument to function as intended by replacing a portion of the instrument with a module of Silverbrook.

Since Ebeling fails to cure the deficiencies of the combination of O'Donnell and Silverbrook, a *prima facie* case of obviousness has not been established for claims 32 and 41. For at least this reason, the rejection of claims 32 and 41 under section 103(a) is improper and should be withdrawn.

**V. Response to the Rejection of Claims 19-20, 25-28 and 47 under  
35 U.S.C. § 103(a)**

The Examiner rejected claims 19-20, 25-28 and 47 under U.S.C. § 103(a) as being unpatentable over O'Donnell in view of Ebeling, in view of Silverbrook and finally in view of Pertrushin.

Claim 19 is directed toward an input device comprising, *inter alia*, “a first and second selectively detachable structure...said second structure containing at least one removable functional module including one of an ink pen module, a lead pencil module, a laser pointer module, or a roller ball mouse module.”

Claim 47 is directed toward a system comprising, *inter alia*, “at least a first and second selectively detachable structures...said second structure containing at least one removable functional module including one of an ink pen module, a lead pencil module, a laser pointer module, or a roller ball mouse module...”.

O'Donnell teaches a writing instrument consisting of a single structure ending in a ball tip wherein the instrument is intended to capture the distance and direction of the ball tip. This distance and direction data is then recorded within the writing instrument. In the OA, the Examiner admits that O'Donnell does not teach the second structure as claimed and adds Silverbrook to cure this deficiency of O'Donnell. The Examiner would attempt to add the isolated modules (laser pointer and pen module) of Silverbrook to the writing instrument of O'Donnell to construct a device similar to the claimed invention. However, since O'Donnell's writing instrument is a single structure, it would need to be destroyed to add the isolated modules of Silverbrook. Additionally, since one of Silverbrook's modules is a pen module and the tip of O'Donnell's writing instrument is a ball tip used in writing, a person of ordinary skill in the art would not attempt exchange

of parts in the manner suggested by the Examiner. The writing instrument is already equipped to be used as a pen. Further, the intention of O'Donnell's invention is to capture the movement of the ball's tip using sensors located near the tip. If one would attempt the add Silverbrook's modules, this intended use would be destroyed.

Therefore, Applicant submits that claims 19-20, 25-28 and 47 are not obvious in view of the combination O'Donnell in view of Ebeling, in view of Silverbrook and finally in view of Pertrushin. Specifically, Applicant submits that by combining the teachings of Silverbrook with that of O'Donnell in the manner suggested by the Examiner would render O'Donnell unsuitable for its intended purpose. According to MPEP 2143.01(V), if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Therefore, if there is no suggestion or motivation to make the proposed modification as suggested by the Examiner, claims 29-30, 33-34, 37-39, 42-43 and 46 cannot be obvious in view of the combination of O'Donnell in view of Ebeling, in view of Silverbrook and finally in view of Pertrushin.

Additionally, according to MPEP 2143.01 (VI), if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Since the tip of O'Donnell writing instrument require sensors to track the movement of the ball's tip, the replacement of one of Silverbrook's modules would not allow O'Donnell's invention to function as intended. Therefore, claims 19-20, 25-28 and 47

cannot be obvious in view of the combination of O'Donnell in view of Ebeling, in view of Silverbrook and finally in view of Pertrushin.

Since O'Donnell in view of Ebeling, in view of Silverbrook and finally in view of Pertrushin do not render claims 19 and 47 obvious, this combination of references cannot render dependent claims 20 and 25-28 obvious because these dependent claims contain all the limitations of their patent claim.

#### **VI. Response to the Rejection of Claims 21 under 35 U.S.C. § 103(a)**

Claim 21 depends from claim 20 and, thus, incorporates the elements of that claim. As mentioned above, the combination of O'Donnell and Silverbrook as proposed by the Examiner would not render claim 20 unpatentable for two reasons. First, the proposed modification of Silverbrook's modules would render the O'Donnell's invention unsatisfactory for its intended purpose. Therefore, there is no suggestion or motivation to make the proposed modification as suggested by the Examiner. Second, the proposed modification of O'Donnell's writing instrument with Silverbrook's modules would change the principle of operation of the prior art invention of O'Donnell. Therefore, the teachings of the references are not sufficient to render the claims *prima facie* obvious.

(See current response, remarks, § V.)

Van Ruymbeke, U.S. Patent No. 6,380,930, is directed toward a laptop touchable with integrated antenna. See *Van Ruymbeke*, Fig. 4. Since Van Ruymbeke fails to cure the deficiencies of the combination of O'Donnell and Silverbrook, a *prima facie* case of obviousness has not been established for claim 21. For at least this reason, the rejection of claim 21 under section 103(a) is improper and should be withdrawn.

**VII. Conclusion**

Applicant submits that the present claims are in condition for allowance and request entry of this amendment, reconsideration and allowance of the pending claims.

Respectfully submitted,

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